

REMARKS/ARGUMENTS

This Amendment responds to the Office Action dated November 10, 2003. Claims 21-27 have been withdrawn as non-elected claims pursuant to the earlier Restriction Requirement. Applicant acknowledges the Examiner's treatment of the election of claims 1-20 as an election without traverse. Applicant reserves the right to prosecute the non-elected claims in a divisional application.

A diligent effort has been made to respond to each of the rejections contained therein. It is believed that this Amendment overcomes those rejections and thus places this case in condition for allowance. The rejections of pending Claims 1 - 20 are respectfully traversed, and reconsideration is respectfully requested. Application respectfully requests that a timely Notice of Allowance be issued in this case.

I. The Examiner Is Interpreting The Claims Improperly

When examining claims for patentability, claims are interpreted as broadly as is reasonable and consistent with the specification.¹ In the Office Action dated November 10, 2003, as in the earlier Office Action dated February 3, 2003, the Examiner attempts to interpret the claims of the present invention inconsistently with the specification. In the latest Office Action, as with the earlier Office Action, the Examiner argues that a building panel having a flat region with a longitudinal stiffening rib, or notch, anticipates the building panel claimed. However, the specification clearly distinguishes the present invention from a building panel having a flat region with a longitudinal stiffening notch:

The present invention is an improved building panel capable of withstanding increased bending moments. The building panel includes a curved central portion in lieu of a straight central

¹ See, e.g., *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

portion. The curved central portion has a concave shape, which provides the building panel with superior rigidity in comparison to the straight central portion. The panel's improved strength and rigidity even surpass that of a building panel having *a straight central portion that includes a notched stiffener*.²

Furthermore, the Examiner argues that the two flat sides of a building panel's flat region separated by a stiffening rib anticipate the "side wall" elements of the invention claimed. However, such an interpretation of the claim term "side wall" is ignoring the ordinary and customary meaning of the claim terms. "The general rule is, of course, that terms in the claim are to be given their ordinary and accustomed meaning."³ The ordinary and customary meaning of the term "side wall" is inconsistent with two flat side elements that together comprise a flat region. The Examiner's interpretation otherwise is improper.

Since the Examiner has consistently attempted to interpret the claims of the present invention inconsistently with the specification and inconsistent with the ordinary and customary meaning of the terms, the rejection of claims 1-20 based on that erroneous interpretation is improper and should be withdrawn.

II. The Examiner Has Failed To Demonstrate A *Prima Facie* Case of Anticipation Utilizing The *Albrecht* Reference

Claims 1-3, 14, 15-17 and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,962,622⁴ issued to Albrecht (hereinafter "*Albrecht*").⁵ To establish a *prima facie* case of anticipation under 35 U.S.C. § 102, the Examiner must

² Application, p. 6, ll. 3-11 (emphasis added).

³ Johnson Worldwide Assocs., Inc. v. Zebco Corp., 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999)

⁴ In previous Office Actions and responses thereto, *Albrecht* was misidentified as U.S. Patent No. 4,962,633.

⁵ 11/10/03 Office Action, p. 2.

demonstrate that a single prior art reference discloses all of the claim's essential elements.⁶

Thus, the "exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference."⁷

A. Albrecht Does Not Disclose a Building Panel Including a Curved Central Portion With Side Wall Portions Extending From Its Opposite Ends

The building panel of claim 1 includes a curved central portion and a pair of *side wall* portions. The side portions extend from the opposite ends of the curved central portion. The Examiner has annotated Fig. 9 of *Albrecht* to indicate what the Examiner argues comprise a curved central portion (172) and side wall portions (170) extending from the opposite ends of the curved central portion.⁸ However, the Examiner is arguing an interpretation of *Albrecht* that *Albrecht* itself does not teach. Rather, *Albrecht* discloses that "a hat-shaped roof deck 168 presenting a *flat region* or crest 170 provided with a stretched-in *stiffening rib* 172."⁹ Furthermore, *Albrecht* distinguishes itself from a building panel having a curved central portion: "In accordance with the present invention, at least one stiffening rib is formed *in the flat region*."¹⁰ According to *Albrecht*, the stiffening rib is part of a flat region. In other words, *Albrecht* neither discloses nor claims a curved central portion as claimed. Rather, as quoted above, *Albrecht* discloses a flat region.

⁶ E.g., *Rockwell Inter. Corp. v. U.S.*, 147 F.3d 1358, 1363, 47 U.S.P.Q.2d 1027, 1031 (Fed. Cir. 1998); *Gechter v. Davidson*, 116 F.3d 1454, 1457, 43 U.S.P.Q.2d 1030, 1032 (Fed. Cir. 1997); *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985); *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

⁷ *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 750 F.2d 1569, 1574, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984).

⁸ 11/10/03 Office Action, p. 2.

⁹ *Albrecht*, col. 7, ll. 62-64.

¹⁰ *Albrecht*, col. 2, ll. 55-56.

Figure 9 of *Albrecht*, as further taught by the text of the specification, shows that the stiffening rib 172 is only part of the larger flat region or crest 170. The stiffening rib 172 of *Albrecht* simply cannot anticipate the curved central portion of the building panel of claim 1--the curved central portion as claimed, and consistent with the specification, which distinguishes the curved central portion of the claimed invention from a flat region with a stiffening notch. A building panel with a flat region central portion, as disclosed in *Albrecht*, is clearly different than a building panel having a curved central portion as claimed. Thus, *Albrecht* does not provide the requisite disclosure to anticipate claim 1.

Applicant also notes that even in what *Albrecht* describes as its "broadest aspects," the building panel of *Albrecht* includes a flat region central portion, not a curved central region. By attempting to characterize the stiffening rib 172 of as a curved central portion, the Examiner is attempting to interpret *Albrecht* more broadly than even the inventor *Albrecht* contemplated.

Applicant has clearly distinguished building panels similar to those in *Albrecht* from the building panel of claim 1: "*Unlike the panel 400 illustrated in Fig. 4, which has a straight central portion 402, the panel of the present invention, as illustrated in Fig. 9, includes a curved central portion 902.*"¹¹ Furthermore, Applicant has distinguished building panels having flat region central portions that include stiffening ribs as in *Albrecht*.

The central portion 402 is straight, and in order to increase that portion's stiffness it may include a notched portion 408. Assuming the central portion includes a notched stiffener, the central portion 402 would be separated into two sub-central portions 404, 406.¹²

¹¹ Application, p. 10 (emphasis added).

¹² Application, p. 2.

The Examiner's designation of the stiffening rib 172 of *Albrecht* as a curved central portion and the Examiner's designation of flat region or crest 170 as a side wall portion is inconsistent with the disclosure in *Albrecht*. Furthermore, the Examiner's designation of the stiffening rib 172 of *Albrecht* as analogous to a curved central portion is inconsistent with the language of claim 1, which particularly points out and distinctly claims the subject matter that *Applicant* regards as his invention.

Each of claims 1-3, 14, 15-17 and 20 includes a curved central portion that is patentably distinct from a flat region with a stiffening rib, as discussed above. Accordingly, *Albrecht* fails to anticipate claims 1-3, 14, 15-17 and 20 of the present invention. Applicant respectfully requests withdrawal of the rejection of the claims.

III. The Examiner Has Failed To Demonstrate A *Prima Facie* Case of Anticipation Utilizing The *Blazley* Reference

Claims 1-3, 8, 9, 14, 15-17, 19 and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,282,936 issued to Blazley (hereinafter "*Blazley*"). As stated earlier, When examining claims for patentability, claims are interpreted as broadly as is reasonable and consistent with the specification.¹³ To establish a *prima facie* case of anticipation under 35 U.S.C. § 102, the Examiner must demonstrate that a single prior art reference discloses all of the claim's essential elements.¹⁴ Thus, the "exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference."¹⁵

¹³ See, e.g., *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

¹⁴ E.g., *Rockwell Inter. Corp. v. U.S.*, 147 F.3d 1358, 1363, 47 U.S.P.Q.2d 1027, 1031 (Fed. Cir. 1998); *Gechter v. Davidson*, 116 F.3d 1454, 1457, 43 U.S.P.Q.2d 1030, 1032 (Fed. Cir. 1997); *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985); *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

¹⁵ *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 750 F.2d 1569, 1574, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984).

As with the *Albrecht* reference, the Examiner urges that a stiffening rib in a longitudinal flat region anticipates the curved central portion of the building panel claimed in the present invention. As stated above with respect to the claims rejected using the *Albrecht* reference, claims 1-3, 8, 9, 14, 15-17, 19 and 20 each recite a building panel that comprises a curved central portion, specifically a curved central portion that is patentably distinct from a longitudinal flat region having a stiffening rib. Accordingly, *Albrecht* fails to anticipate claims 1-3, 8, 9, 14, 15-17, 19 and 20 of the present invention. Applicant respectfully requests withdrawal of the rejection of the claims.

IV. The Examiner Has Failed To Demonstrate A *Prima Facie* Case of Obviousness Utilizing The *Albrecht* Reference

Claims 4-11, 18 and 19 stand rejected under 35 U.S.C. § 103(a) as being obvious in view of *Albrecht*.¹⁶ The Examiner can satisfy her burden of establishing a *prima facie* case of obviousness "***only by showing some objective teaching*** in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."¹⁷ In this case, the Examiner cites only one reference, *Albrecht*, to render Claims 4-11, 18 and 19 obvious. Modifying a single reference to support a determination of obviousness is improper absent a sufficient teaching or suggestion in the prior art to make such a modification.¹⁸ Thus, modifications to a prior art reference are improper without evidence of a

¹⁶ 11/10/03 Office Action, p. 3.

¹⁷ *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (emphasis added).

¹⁸ *See In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) (stating that "[a]lthough couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious 'modification' of the prior art").

specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of [the applicant's] invention to make the combination in the manner claimed.¹⁹

Here, consistent with the above remarks concerning claim rejections under 35 U.S.C. § 102(b), it is clear that *Albrecht* does not disclose all of the claimed elements. Thus, the Examiner must point to some particular teaching or suggestion in *Albrecht* that supports modifying the reference to provide a building panel including a curved central portion and side wall portions extending from opposite ends of the curved central portion, as claimed in independent claims 1 and 14. The Examiner has failed to cite any support in *Albrecht* that suggests modifying the reference in such a manner because such a teaching does not exist. In fact, *Albrecht* describes the "broadest aspects" of the building panel disclosed, and admits that even in its broadest aspects, the building panel of *Albrecht* includes a flat region central portion.²⁰

As discussed above, a lack of evidence showing some objective teaching in *Albrecht* or that knowledge generally available to one of ordinary skill in the art that would lead that individual to modify *Albrecht* necessitates the removal of the current obviousness rejection.

V. The Examiner Has Failed To Demonstrate A *Prima Facie* Case of Obviousness Utilizing The *Blazley* Reference

Claims 4-7, 10, 11 and 18 stand rejected under 35 U.S.C. § 103(a) as being obvious in view of *Blazley*.²¹ The Examiner can satisfy her burden of establishing a *prima facie* case of obviousness "***only by showing some objective teaching*** in the prior art or that knowledge

¹⁹ *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (holding that the Board did not make out a proper *prima facie* case of obviousness when it modified a single reference without a specific motivation to make such a modification).

²⁰ *Albrecht*, col. 2, ll. 43-56.

²¹ 11/10/03 Office Action, p. 4.

generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."²² In this case, the Examiner cites only one reference, *Blazley*, to render Claims 4-7, 10, 11 and 18 obvious. Modifying a single reference to support a determination of obviousness is improper absent a sufficient teaching or suggestion in the prior art to make such a modification.²³ Thus, modifications to a prior art reference are improper without evidence of a

specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of [the applicant's] invention to make the combination in the manner claimed.²⁴

Here, consistent with the above remarks concerning claim rejections under 35 U.S.C. § 102(b), it is clear that *Blazley* does not disclose all of the claimed elements. Thus, the Examiner must point to some particular teaching or suggestion in *Blazley* that supports modifying the reference to provide a building panel including a curved central portion and side wall portions extending from opposite ends of the curved central portion, as claimed in independent claims 1 and 14. The Examiner has failed to cite any support in *Blazley* that suggests modifying the reference in such a manner because such a teaching does not exist. In fact, *Blazley* describes element cited by the Examiner as nothing more than a stiffening rib,²⁵ which is precisely the sort of prior art distinguished by the invention claimed.

²² *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (emphasis added).

²³ *See In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) (stating that "[a]lthough couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art").

²⁴ *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (holding that the Board did not make out a proper *prima facie* case of obviousness when it modified a single reference without a specific motivation to make such a modification).

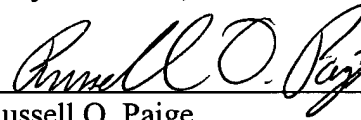
²⁵ *Blazley*, Abstract; col. 7, ll. 37, 45, 53, 60.

As discussed above, a lack of evidence showing some objective teaching in *Blazley* or of knowledge generally available to one of ordinary skill in the art that would lead that individual to modify *Blazley* necessitates the removal of the current obviousness rejection.

VI. Summary

Because neither *Albrecht* nor *Blazley* discloses (i) a building panel including a curved central portion or (ii) a building panel including a pair of side portions extending from the opposite ends of the curved central portion, the Examiner has failed to establish a *prima facie* case of anticipation against the claims of the present invention. Also, because the Examiner has not pointed to any specific evidence that suggests modifying *Albrecht* or *Blazley* in the manner claimed in the present invention, the Examiner has not established a *prima facie* case of obviousness against those claims. For the reasons stated above, Applicant believes those claims, as currently presented, are in condition for allowance and respectfully requests reconsideration and allowance of the pending claims.

Respectfully submitted,

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